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No. 80-155

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1980

AMSTAR CORPORATION,

Petitioner,

v.

DOMINO'S PIZZA, INC.; ATLANTA PIZZA, INC.; PIZZA ENTERPRISES, INC.; PIZZA SERVICES, INC.; and HANNA CREATIVE ENTERPRISES, INC.,

Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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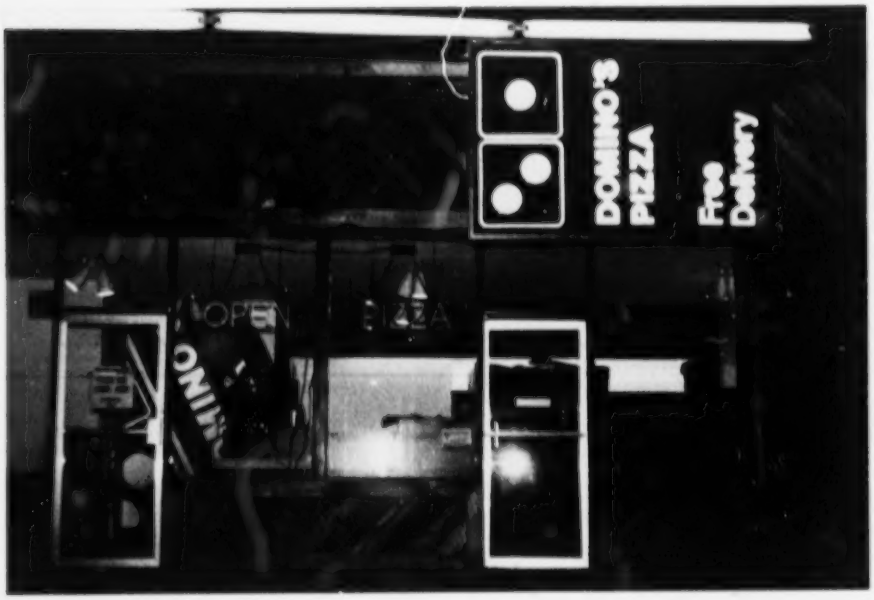
INTRODUCTION

Respondents (hereinafter DPI) operate the largest pizza delivery chain in the United States, with annual sales in 1978 approaching $50,000,000. DPI's outlets, which do not even provide sit-down eating facilities, are principally located adjacent to college campuses and military bases. DPI's DOMINO'S PIZZA stores[1] engage

[1] Contrary to implications in the Petition, DPI does not use DOMINO'S alone and has not done so for eight years or more.

exclusively in the sale of hot pizza pies and cola beverages[2] and typically appear as follows:



For more than 50 years, petitioner's sales were limited to sugar and sugar-related items. After DPI adopted the DOMINO'S PIZZA mark, petitioner commenced distribution to the institutional food trade (restaurants, hospitals, cafeterias, etc.) of single service condiment packets. Current sales of such packets, 20-30% of which

[2]While DPI experimented, on a very limited basis, with the sale of frozen pizza, the experiment was discontinued well prior to the commencement of this action. DPI's sales of sugar and salt to which Amstar alludes are restricted solely to its company-owned and franchised stores for use in making pizza.

do not bear a DOMINO label, are less than $15,000,000 a year, and the packets are provided to the public free of charge. From the standpoint of consumer purchases, petitioner's mark still typically appears as follows:

Because of differences in the goods and the marks and dissimilarities in their respective customers, channels of trade and advertising, the United States Court of Appeals

for the Fifth Circuit concluded that there was no likelihood of confusion between DOMINO'S PIZZA pizza and DOMINO sugar. Being essentially factual, that conclusion should not be subject to review by writ of certiorari.

ARGUMENT

As a general rule, the Supreme Court will "not grant a certiorari to review evidence and discuss specific facts." *United States v. Johnston*, 268 U.S. 220, 227 (1925). Rather, certiorari is principally limited to resolution of conflicts between circuit courts and to settlement of important questions of federal law. Supreme Court Rule 17. Amstar labors mightily to bring itself within the latter two categories. It labors in vain.

For example, Amstar insists that without guidance as to the meaning of likelihood of confusion, "courts will continue to exhibit what has been referred to as 'judicial schizophrenia.'" Pet. 9.[3] The source from which Amstar quotes had reference, however, to "a difference of opinion which opened among *Second Circuit judges* from about *1940 to 1960.*" 2 McCarthy, *Trademarks and Unfair Competition*, § 24.9 (1973), at 143 (emphasis supplied). The sanity of the Fifth Circuit in 1980 is not thus at issue; it applied here the same test universally applied in other cases and by other Courts of Appeal:

> In this circuit likelihood of confusion is determined by evaluating a variety of factors including the type of trademark at issue; similarity of product; identity of retail outlets and purchasers;

---

[3]References are to the "Petition for Writ of Certiorari" (Pet. ___) and to the Appendix thereto (A___).

> identity of advertising media utilized; defendant's intent; and actual confusion.

A78; *Roto-Rooter Corporation v. O'Neal,* 513 F.2d 44, 45 (5th Cir. 1975); *see,* Restatement, *Torts,* § 729 (1938).[4]

Far more pertinent to this case, therefore, is Professor McCarthy's observation that:

> [T]he citation of precedent on the issue of likelihood of confusion can only indicate a general pattern. Legal precedent is of minor value because each case must rest on the totality of its own facts as to a likelihood of confusion. The Court of Customs and Patent Appeals has admitted that the determination of a likelihood of confusion is a "subjective evaluation" in which prior decisions are of little value, and provide "but meager assistance."

2 McCarthy, *supra,* § 23.11 (footnotes omitted); *accord,* Gilson, *Trademark Protection and Practice,* § 5.01 (1974). In no area of law may it be more accurately stated that "[e]ach case must be decided on its own facts and the differences are often subtle ones." *Industrial Nucleonics Corp. v. Hinde,* 475 F.2d 1197, 1199 (C.C.P.A. 1973); *accord, Interstate Brands Corp. v. Celestial Seasonings, Inc.,* 576 F.2d 926, 927 (C.C.P.A. 1978).

To no avail, therefore, are petitioner's contentions that the Fifth Circuit: (a) misjudged the significance attributable to differences in the goods to which the trademarks at issue are applied; and (b) attached excessive weight to third party users of "Domino." Pet. 9-14. Factually, grocery store sugar and home delivered

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[4]A more complete listing of factors was collected in Appendix A to DPI's "Reply Brief" to the Fifth Circuit, and this table is reprinted as Appendix A hereto.

pizza are highly dissimilar products distributed through distinctly dissimilar "retail outlets" (A84); and 72 third party *federal registrations*[5] of "Domino", many for food products, can no more be ignored than extensive evidence of third party use. A79-80. More importantly, these factors were only two of a multitude of considerations deemed relevant to an assessment of the likelihood of confusion. A77-78. Equally determinative were the Fifth Circuit's findings that:

> i. ["Domino"] is a common English name for a game, a hooded costume, a type of mask, and a theory of political expansion. Thus, "Domino" is not a coined word, is not purely fanciful, and while its application to sugar may be artibrary, it is not to be accorded the same degree of protection given such coined and fanciful terms as "Kodak" or "Xerox." [A81-82; footnote omitted.]
>
> ii. "Domino," in possessive form, next to the word "pizza," produces a commercial impression quite different from the same mark placed next to "sugar." "Domino" is derived from Latin, is an Italian surname, and in combination with "pizza" creates an Italian connotation. . . . The impression conveyed by defendants' use of "Domino's Pizza" is substantially different from that created by plaintiff's use of "Domino Sugar." [A83.]
>
> iii. There are substantial dissimilarities between the predominant purchasers of plaintiff's and defendants' products. . . . "Domino's Pizza" patrons are primarily young (85.6% under 35

[5]The third party federal registrations are set forth in Appendix B hereto.

years of age), single (61%) males (63.3%). . . . "Domino" sugar purchasers are predominantly middle-aged housewives. [A85.]

iv. Defendants' advertising program is geared to seek out and exploit a highly localized and rather specialized class of consumers. Defendants have not sought to mine the good will established by plaintiff. In short, hardly anyone would confuse a "Domino" sugar ad with a "Domino's Pizza" sales pitch, nor would they likely believe the two advertisements emanated from the same source, considering the significant differences between the advertisements in message content and presentation. [A86.]

v. There is no evidence that defendants have ever attempted to "pass off" their goods as those of plaintiff. . . . There is no evidence the ["Domino's Pizza"] name was adopted with any intent to confuse, mislead, or deceive the public. [A86-87; footnote omitted.]

vi. In view of the fact that both plaintiff's and defendants' sales currently run into the millions of dollars each year, . . . isolated instances of actual confusion are insufficient to sustain a finding of likelihood of confusion. [Citations omitted.] Indeed, the fact that only three instances of actual confusion were found after nearly 15 years of extensive concurrent sales under the parties' respective marks raises a presumption against likelihood of confusion in the future. [A87; citations omitted.]

vii. Plaintiff brought this suit after nearly ten years of simultaneous use of the mark "Domino" by Amstar and DPI. A trademark owner that strongly believed its customers were being

> deceived would hardly have remained idle for such an extended period of time. [A91.]

It is simply specious, therefore, for the petitioner to conclude that:

> If this decisions is permitted to stand, . . . the Coca-Cola Company may be precluded from enforcing its well-known mark against COCA-COLA pizza, or Kraft Foods may be precluded from enforcing its house mark against KRAFT pizza . . . .

Pet. 15. This is not a COCA-COLA case or a KRAFT case; it is a "Domino" case. Indeed, as the Fifth Circuit explicitly noted, "'if the Coca-Cola Company should permit COCA-COLA or COKE to be used for rain coats, cigarette lighters, golf balls, or jewelry not of its manufacture, it would not take long for even [this giant] in the trademark world to be reduced to pigmy size.'" A80. "Domino" has and does appear on "cigarettes and matches, which are currently sold in grocery stores, two restaurants currently operating . . ., a small chain of supermarkets in the Bronx . . ., and a 'Domino Donut Mix' distributed by General Mills to commercial bakers since 1959." A79. "Domino" has been registered for "canned fruits, citrus, cigarettes, cheese, wheat flours, chrome-tanned leather, canned sardines, animal feed, envelopes, pencils, fishing line, candy mints, whiskey, ladies' hosiery and haircream." *Id.* Having "not been vigilant in protecting its rights" in the past (A90), Amstar cannot hypothesize the same types of confusion which might arise from third party use of a truly famous trademark; and the Fifth Circuit has factually determined that as between "Domino" and "Domino's Pizza," there is no likelihood of confusion at any level.

CONCLUSION

The decision below does not introduce a conflict between circuits or consider an important question of federal law which should be settled by this Court. It is almost exclusively factual in content and should not thus be reviewed by writ of certiorari. Therefore, respondents request that the Petition for a Writ of Certiorari be denied.

Respectfully submitted,

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September 4, 1980

APPENDIX

APPENDIX A

TABLE OF FACTORS IN TRADEMARK CASES RELEVANT TO LIKELIHOOD OF CONFUSION

FACTORS	FAVORS DOMINO'S PIZZA
1. GOOD FAITH	
(a) Adoption	x
(b) Use	x
2. ABSENCE OF DISTINCTIVENESS OF DOMINO MARK	
(a) Third-party uses and registrations	x
(b) Not a coined or fanciful word	x
(c) Not a prestige type mark (Gucci, Tiffany)	x
(d) Basically restricted to use on sugar until 1965	x
(e) No evidence of public awareness for products other than sugar	x
(f) Absence of likelihood or intention to expand into each other's field	x
3. THE NATURE OF THE DOMINO MARK	
(a) A surname	x
(b) Common word	x
4. DISSIMILARITY BETWEEN THE MARKS	
(a) Commercial impression and logo	x
(b) Italian connotation of Domino's Pizza	x

FACTORS	FAVORS DOMINO'S PIZZA
(c) Appearance (Domino bag-Domino's Pizza and design)	x
(d) Sound (Domino-Domino's Pizza)	-
5. DISSIMILARITY IN CHANNELS OF TRADE	x
6. DISSIMILARITY OF GOODS AND SERVICES	x
7. DISSIMILARITY OF CUSTOMERS	
(a) young v. old	x
(b) men v. women	x
(c) college students and military v. housewives	x
8. DISSIMILARITY OF ADVERTISING	x
9. ABSENCE OF ACTUAL CONFUSION	
(a) Absence of any evidence of misdirected mail, complaints, etc.	x
(b) Fourteen years of concurrent use	x
(c) Massive sales volume of both parties	x
(d) Absence of Amstar employee, officer or broker awareness of alleged conflict	x
(e) Absence of credible survey evidence of confusion	x
(f) Absence of confusion in survey of Domino's Pizza customers (3 of 700)	x

FACTORS	FAVORS DOMINO'S PIZZA
10. LACHES	
(a) Failure of Amstar to bring suit for ten years	x
(b) Failure of Amstar to seek injunctive relief against Domino's Pizza when suit filed	x
(c) Failure of Amstar to allege "likelihood of confusion" even in 1971 letter	x
(d) Failure of Amstar to take action while observing Domino's Pizza's rapid growth	x
11. AMSTAR'S INACTION AGAINST THIRD PARTIES	
(a) Failure to seek injunctive relief against anyone	x
(b) Occasional protest letters not followed up by any action by Amstar	x
12. DETERMINATIONS BY TRADEMARK EXAMINERS TO GRANT DOMINO'S PIZZA REGISTRATIONS DESPITE AMSTAR'S REGISTRATIONS	x
13. COEXISTENCE OF MANY WELL-KNOWN MARKS IN FOOD FIELD—INCLUDING SUGAR	x
14. PUBLIC POLICY AGAINST PERMITTING MONOPOLIZATION OF WORD MARKS	x
15. EQUITABLE CONSIDERATIONS	
(a) Court's repeated acknowledgment of difficulty in resolving issue	x

FACTORS	FAVORS DOMINO'S PIZZA
(b) Good will established by Domino's Pizza over 14 years	x
(c) Devastating impact on Domino's Pizza	x
(d) Absence of injury to Amstar	x
(e) Excessive scope of decree	x
(f) Verbatim adoption of Amstar's findings and conclusions by court	x
16. No Dilution of Amstar's Mark	
(a) No tarnishment of reputation	x
(b) Not a Rolls Royce or Kodak type mark	x

APPENDIX B

THIRD-PARTY FEDERAL REGISTRATIONS

MARK	PRODUCT	REG. NO.
DOMINO	Cheese	38,991
DOMINOES	Tablet candy	43,141
DOMINO plus design	Wheat flour	59,232
DOMINO CLUB	Whiskey	59,395
DOMINO	Chewing gum	72,117
DOMINO BRAND	Canned fruits	75,928
DOMINO plus design	Rice	79,051
DOMINO	Chrome-tanned leather	83,572
DOMINO plus design	Oranges, lemons, grapefruit, limes and tangerines	83,982
DOMINO	Coffee	89,558
DOMINO	Chewing gum	92,285
DOMINO	Canned sardines	100,846
DOMINO	Fertilizers	105,126
DOMINO plus design	Mixed stock feed suitable for horses, stock, cattle and poultry	108,170
DOMINO plus design	Horse, dairy and poultry feed	114,074
DOMINO	Envelopes	117,720
DOMINO	Olive-oil	118,818

MARK	PRODUCT	REG. NO.
DOMINO	Vermicelli, macaroni, spaghetti, alimentary pasta and condiments	120,436
DOMINO plus design	Canned vegetables and canned olives	120,664
DOMINO plus design	Vegetable shortening	123,260
DOMINO	Eggs, creamery-butter, mustard, cloves, sage, ginger	123,961
DOMINO	Pencils	131,081
DOMINO plus design	Salt	139,175
DOMINO PEPOLENE	Horse feed	144,616
FAT BACK DOMINOS	Hog meat, pork, and fat back	154,809
DOMINO	Matches	171,994
DOMINO plus design	Matches	171,995
DOMINO plus design	Popcorn confection consisting principally of popcorn with a small admixture of peanuts and candy, put up in cartons	182,091
DOMINO	Fishing line	182,285
DOMINO	Non-alcoholic, non-cereal, maltless beverages	198,967
MYLES DOMINO E-Z RUN SALT	Salt	215,460

MARK	PRODUCT	REG. NO.
DOMINO MINTS	Candy mints	241,329
DOMINO	Jute back cloth	263,884
DOMINO PEL-ETS	Poultry, rabbit, dog, dairy and livestock feed	275,537
DOMINO DOG-ETS	Compressed food for dog, puppy, fox, racoon, sable and all carniverous and fur-bearing animals	285,936
DOMINO PIGEON-ETS	Ration for pigeons compressed into pellets	291,861
DOMINO plus design	Cigarettes	305,237
DOMINO	Tobacco and cigarettes	305,239
DOMINO	Whiskey	320,488
DOMINO	Gin	322,160
DOMINO plus design	Paper bags	386,546
DOMINO	Cutlery, particularly table knives and forks	390,083
DOMINO	Publication published periodically—namely mystery stories	422,058
DOMINO plus design	Cigarettes	431,205
DOMINO	Hectograph carbon paper	502,698
DOMINO	Solvent for use in duplicating process	505,818
DOMINO plus design	Tennis and badminton rackets	516,738

MARK	PRODUCT	REG. NO.
DOMINO	Ready mixed paints, enamels and varnishes	525,628
DOMINO	Peanut oil used as a salad and cooking oil	530,173
DOMINO	Phonograph records	547,455
DOMINO plus design	Gloves made of fabric	565,192
DOMINO plus design	Cigarettes	586,112
DOMINO plus design	Ladies hosiery	608,364
PINK DOMINO	Haircream	609,263
DOMINO plus design	Furniture polish, metal polish, floor wax and automobile wash	616,716
DOMINO	Electrical resistors	618,969
DOMINO	Electric control panels destined for interlocking systems for railways; electric remote control systems for sluices and mines; and electric intercommunicating systems	640,944
DOMINO	Curtains, draperies and bedspreads and fabrics	664,802
DOMINO	Trading stamps	673,654
DOMINO	Modular seating and table units	700,974
DOMINO with design	Phonograph records	710,267

MARK	PRODUCT	REG. NO.
DOMINO with design	Sweaters and sportshirts	710,319
DOMINO	Watch bracelets and identification bracelets	711,217
DOMINO	Electrical circuit components, particularly capacitors and resistors	746,508
DOMINO BRIDGE plus design	Card game apparatus	813,377
DOMINO DRI	Men's and boys' raincoats	814,082
DOMINO	Cigarettes	832,403
DOMINO	After shave lotion and talcum powder; toilet soap	871,448
DOMINO	Men's full dress suits	865,028
DOMINO DOCKS	Concrete boating docks for mooring boats	880,593